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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,044	09/24/2003	Tateo Kawamura	JP920020131US1/4182P	6706
45728 7590 09/26/2008				
IBM ST-SVL				
SAWYER LAW GROUP LLP				
2465 E. Bayshore Road, Suite No. 406				
PALO ALTO, CA 94303				
EXAMINER				
PESIN, BORIS M				
ART UNIT		PAPER NUMBER		
2174				
NOTIFICATION DATE		DELIVERY MODE		
09/26/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@sawyerlawgroup.com

Office Action Summary

Application No.

10/671,044

Applicant(s)

KAWAMURA ET AL.

Examiner

BORIS PESIN

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-33 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-33 and 38-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This communication is responsive to the amendment filed 6/19/2008. Claims 26-33 and 38-40 are pending in this application. Claims 26, and 38 are independent claims. In the amendment filed 6/19/2008, none of the claims were amended. This action is made Non-Final.

Foreign Priority

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a **certified** English translation of the foreign application must be submitted in reply to this action. 37 CFR 41.154(b) and 41.202(e).

Failure to provide a certified translation may result in no benefit being accorded for the non-English application.

Furthermore, rule § 1.55 (a)(3) states

The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than provided in paragraphs (a)(1) or (a)(2) of this section:

- (i) When the application becomes involved in an interference (see § 41.202 of this title),
- (ii) When necessary to overcome the date of a reference relied upon by the examiner, or

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(iii) When deemed necessary by the examiner.

(4)

(i) An English language translation of a non-English language foreign application is not required except:

(A) When the application is involved in an interference (see § 41.202 of this title),

(B) When necessary to overcome the date of a reference relied upon by the examiner, or

(C) When specifically required by the examiner.

(ii) **If an English language translation is required, it must be filed together with a statement that the translation of the certified copy is accurate.**

The Applicant has not provided a certified translation. Even though in the response section the Applicant states, "[a]ccordingly, Applicant has filed a certified English translation and a statement that the translation of the certified copy is accurate, a copy of which is attached hereto," the Examiner can not locate a certified copy of the English translation in the record.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

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be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 26-33 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. (US 2004/0119740) in view of Smith (US 6792448).

In regards to claim 26, Chang teaches a processor-implemented document display system, comprising:

means for extracting a relationship between a plurality of documents in a group of documents (i.e. *"The thread detection module 240 is configured to categorize the received electronic message into an appropriate thread. For example, the received message may be part of a thread which relates to choosing a time among multiple people to play hockey. In other embodiments, various subjects may be discussed and comprise a thread"* Paragraph [0032]);

selecting the relationship, the group of documents associated with the relationship, and an expansion condition for each document of the group of documents (i.e. *"A symbol 830 represents a suppressed message(s). The*

suppressed message(s) are available for viewing in response to a request and are hidden to allow a condensed viewing of the plurality of messages 820, 835, and 850). " Paragraph [0069], Paragraph [0036] and Figure 8, Element 810);

forming a section group that includes the group of documents selected according to the relationship (Figure 8, Element 810);

generating a virtual document from the group of documents (i.e. "The display module 210 is configured to format the received electronic message based on instructions from the control module 250. In one embodiment, the control module 250 instructs the display module 210 to generate the displayed electronic message. The displayed electronic message may include content of the received electronic message with selected portions elided in response to header module 220, the repeated text module 230, the signature module 260, and/or the elision module 270. In one embodiment, the display module 210 is configured to generate a plurality of displayed electronic messages which correspond to a plurality of received electronic messages." Paragraph [0036], Paragraph [0069], and Figure 8).

Chang does not specifically teach identifying an association between the documents in a thread in the virtual document, as a tree structure; and selectively realizing the expansion condition of the thread in the virtual document, based on the tree structure. Smith teaches, identifying an association between the documents in a thread in the virtual document, as a tree structure (See Figure 3, Element 42, the conversation is formed into a tree structure); and selectively realizing the expansion condition of the thread in the virtual document, based on

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the tree structure (See Figure 3, Elements 43, 80, 82, 84, and 86, the user is able to either expand or contract any branch of the tree regardless of the content.) It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang with the teachings of Smith and include a method to present a document as a tree structure and provide the user with the ability to expand or contract any portion of the tree with the motivation to provide the user a more robust messaging system where the user is easily able to follow the thread of the conversation and quickly remove any information that is superfluous.

In regards to claim 27, Chang-Smith teaches a system according to claim 1, wherein the virtual document generation means forms the section group by embedding a document header and a level indicating a depth of hierarchy from a main document (See Chang Figure 8).

In regards to claim 28, Chang-Smith teaches a system according to claim 1, wherein the related information storage means stores information of a parent document related to the document read from a document storage means (i.e. *"The thread detection module 240 is configured to categorize the received electronic message into an appropriate thread. For example, the received message may be part of a thread which relates to choosing a time among multiple people to play hockey."* Chang Paragraph [0032]).

In regards to claim 29, Chang-Smith teaches a system according to claim 1, wherein the extracted relationship comprises a hierarchical relationship (i.e. *"The thread detection module 240 is configured to categorize the received*

electronic message into an appropriate thread. For example, the received message may be part of a thread which relates to choosing a time among multiple people to play hockey.” Chang Paragraph [0032] and Figure 8).

In regards to claim 30, Chang-Smith teaches the system according to claim 1, wherein the extracted relationship comprises a thread; and wherein the group of documents form a message (i.e. *“The thread detection module 240 is configured to categorize the received electronic message into an appropriate thread. For example, the received message may be part of a thread which relates to choosing a time among multiple people to play hockey.”* Chang Paragraph [0032] and Figure 8).

In regards to claim 31, Chang-Smith teaches the system according to claim 22, further comprising an expansion condition storage unit for storing an expansion condition of the message, wherein the virtual document generation unit generates a section by fetching an expansion condition of the message from the expansion condition storage unit (*“A symbol 830 represents a suppressed message(s). The suppressed message(s) are available for viewing in response to a request and are hidden to allow a condensed viewing of the plurality of messages 820, 835, and 850.”* Chang Paragraph [0069]).

In regards to claim 32, Chang-Smith teaches the system according to claim 23, further comprising a user interactive processing unit for accepting an expansion request to a header from a user, wherein the virtual document generation unit is used to add the message to the virtual document on the basis of the expansion request accepted by the user interactive processing unit (*“The*

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elision module 270 is configured to selectively suppress a portion of the received electronic message. In one embodiment, the elision module 270 suppresses the repeated text, the header information, and/or the signature information in response to the repeated text module 230, the header module 220, and the signature module 260, respectively. In one embodiment, the elision module 270 selectively suppresses portion(s) of the received electronic message in response to the control module 250." Chang Paragraph [0034]).

In regards to claim 33, Chang-Smith teaches the system according to claim 23, wherein the documents in the messages comprise a collection of documents that are unscheduled for editing (See Chang Figure 8, none of the messages are scheduled for editing, they are all received messages).

Claims 38-40 are similar in scope to claims 26, 31, and 32; therefore they are rejected under similar rationale.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BORIS PESIN whose telephone number is (571)272-4070. The examiner can normally be reached on Monday-Friday except every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Boris Pesin/
Examiner, Art Unit 2174